

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated March 24, 2006, is respectfully requested in view of this amendment. By this amendment, claims 1, 2 and 5 have been amended, and new claims 7-14 have been inserted. Claims 1-14 are pending in this application.

The amendment to claim 1 describes the diaphragm being configured in a manner calculated to substantially reduce vignetting produced by a natural decrease in light intensity associated with an imaging lens. Support for this feature is found in the Specification *inter alia*, at page 1, lines 21-27. New claim 7 includes limitations derived from claim 2. New claims 8-14 present the invention as a method, based on the descriptions in claims 1-7. It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

In the outstanding Office Action, the Examiner rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,530,628 (*Ngai*), and rejected claims 2-6 under 35 U.S.C. §103(a) as being unpatentable over *Ngai*. These rejections, as applied to the revised claims, are respectfully traversed.

Rejection under 35 USC §102

Claim 1 was rejected under 35 USC 102(b) as anticipated by *Ngai*.

Response

Ngai is cited as disclosing a linear light source, a linearly formed optical element and a diaphragm. Applicant's claim 1 defines

... a light source (1, 9) ... having at least one linearly formed optical element (2, 10)... at least one diaphragm (6) which effects a variable numerical

aperture in the direction of the line, in a manner calculated to substantially reduce vignetting produced by a natural decrease in light intensity associated with an imaging lens.

There is no suggestion in *Ngai* of the use of diaphragm to effect a variable numerical aperture in the direction of the line. Therefore, *Ngai* cannot suggest the use of diaphragm to effects a variable numerical aperture in the direction of the line in a manner calculated to substantially reduce vignetting produced by a natural decrease in light intensity associated with an imaging lens.

Newly-submitted independent claim 8 includes limitations similar to those of claim 1, and should be allowable for the above reason.

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 2-6 under 35 U.S.C. 103(a) in view of *Ngai*.

Response

This rejection is respectfully traversed, and withdrawal of the rejection is respectfully requested. *Ngai* provides an illuminated projector, in which a reflector and a Fresnel lens (or at least a prismatic lens) is used to distribute light. There is no suggesting of any attempt to reduce vignetting, and from the general description in *Ngai*, there is no indication that vignetting would be a design issue in the application described. The purpose is to provide general diffuse lighting to a general area such as a work surface.

Moreover, there is no suggestion in the *Ngai* reference of the features of the use of diaphragm to effects a variable numerical aperture, and the use of diaphragm to effects a variable numerical aperture in the direction of the line in a manner calculated to substantially reduce vignetting.

Referring to the use of *Ngai's* diaphragm, the standard for obviousness, as a matter of law, requires a motivation to modify the *Ngai* device.

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103.

Obviousness is a question of law based on the following factual inquiries: 1) the scope and content of the prior art, 2) the differences between the prior art and the claims, 3) the level of ordinary skill in the art, and 4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Motivation is Absent in the Prior Art

It is well established, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from Applicants' invention itself. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Oetiker's invention was an improvement in a hose clamp. The references applied by the Examiner consisted of an earlier Oetiker patent relating to a hose clamp and the Lauro '400 patent, relating to a hook and eye fastener for use in garments. The Court concluded that the references were improperly combined. It stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

Diversitech Corp v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

Applicants therefore submit that in the present case it has not been shown that one constructing the *Ngai* lamp would be motivated to achieve linear illumination while avoiding vignetting. While "substantially uniform luminescence" is addressed by *Ngai*, *Ngai*, uses the Fresnel lens and the reflector to achieve this. Specifically, there is no attempt by *Ngai* to provide Applicant's linear illumination while avoiding edge vignetting. Further there is no attempt by *Ngai* to eliminate edge vignetting by use of a shaped diaphragm.

Since the dependent claims address specific characteristics of the diaphragm (or variable numerical aperture), a showing of obviousness under 35 U.S.C. 103(a) would necessarily have to address the diaphragm. It is respectfully submitted that there is no such suggestion in the cited art.

Applicant respectfully requests that the Examiner withdraw the rejections and the case be passed to issuance.

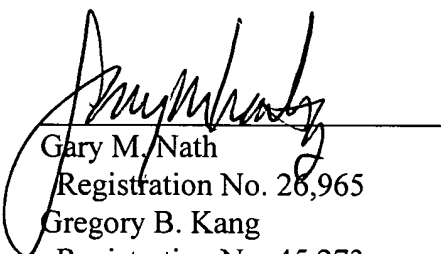
CONCLUSION

In light of the foregoing, Applicants submit that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner call the undersigned.

Respectfully submitted,
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